

PATENT
Customer No. 22,852
Attorney Docket No. 9404.0024-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Darrin BAST *et al.*) Group Art Unit: 1614
)
Serial No.: 10/758,506) Examiner: K. WEDDINGTON
)
Filed: January 15, 2004) Confirmation No. 5807
)
For: METHODS OF USE OF)
GEMIFLOXACIN COMPOUNDS)
AGAINST FLUOROQUINOLONE)
RESISTANT STREPTOCOCCUS)
PNEUMONIAE BACTERIA)

**Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office action mailed October 8, 2004, Applicants submit the following remarks. A request for a one month Extension of Time accompanies this Response, which is therefore timely filed.

The Office action imposes a restriction requirement. According to the Office, pending claims 1-11 are directed to two distinct inventions:

- I. Claims 1, 2, 5-7, and 9-11, drawn to a method for modulating the metabolism of fluoroquinolone resistant pathogenic bacteria with a composition comprising gemifloxacin, classified in class 514, subclasses 311 and 312; and

II. Claims 3, 4, and 8, drawn to a method for treating or preventing a bacterial infection by fluoroquinolone resistant pathogenic bacteria with a composition comprising gemifloxacin, classified in class 514, subclasses 311 and 312.

Office action, page 2.

Applicants elect, with traverse, Group I, directed to claims 1-2, 5-7, and 9-11.

Applicants traverse the rejection on the following grounds. Restriction is proper when two criteria are met. First, the inventions must be independent or distinct as claimed. Second, there must be a serious search burden on the Examiner. "If the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803. The Examiner has not shown that these criteria are met.

Both of the allegedly separate and distinct inventions fall within class 514, subclasses 311 and 312. The Examiner's search of the art relative to elected claims 1-2, 5-7, and 9-11 will also constitute a search of the subject matter of the claims 3, 4 and 8. In addition, Examiner Weddington searched and examined claims 1-11 together in parent application number 10/323,101. Consequently, there is no additional burden on the Examiner associated with examining all pending claims in this application. In the absence of a serious burden, the restriction requirement is improper and the Examiner should withdraw it.

For these reasons, Applicants request that the Examiner reconsider and withdraw the restriction requirement, and examine the full scope of claims 1-11 in this application. If, however, the Examiner maintains the restriction requirement, Applicants


request that the requirement be made final so that they may file a petition to the Commissioner of Patents seeking review of that decision.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 12, 2004

By: 
Steven P. O'Connor
Reg. No. 41,225
(571) 203-2718